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APPLICATION NO.	L_	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO. 3886	
10/049,452		06/14/2002	Kimberly L.P. Hei	163.0104USWO		
23552	7590	08/06/2003				
MERCHANT & GOULD PC P.O. BOX 2903				EXAMINER		
		N 55402-0903	MCAVOY, ELLEN M			
				ART UNIT	PAPER NUMBER	
				1764		
			DATE MAILED: 08/06/2003			

Please find below and/or attached an Office communication concerning this application or proceeding.

	<b>V</b> (1)	1						
		Applicat	tion No.	Applicant(s)	- <del></del>			
	Office A-41 C-	10/049,4	452	HEI ET AL.				
	Office Action Summary	Examine	er .	Art Unit				
		Ellen M l	•	1764				
Period fo	The MAILING DATE of this communic or Reply	ation appears on th	ne cover sheet wi	th the correspondence addres	s			
THE   - External after   - If the   - If NO   - Failu   - Any r	ORTENED STATUTORY PERIOD FO MAILING DATE OF THIS COMMUNIC nsions of time may be available under the provisions of SIX (6) MONTHS from the mailing date of this communication of the provided for reply specified above is less than thirty (30) period for reply is specified above, the maximum stature to reply within the set or extended period for reply well are to reply within the set or extended period for reply well are to reply within the set or extended period for reply well are to reply within the set or extended period for reply well are to reply within the set or extended period for reply well are to reply received by the Office later than three months after the provisions of the provi	CATION.  f 37 CFR 1.136(a). In no e nication.  days, a reply within the statory period will apply and vill.  by statute, cause the ap	vent, however, may a re atutory minimum of thirt will expire SIX (6) MON' plication to become AB	eply be timely filed y (30) days will be considered timely. THS from the mailing date of this commun	nication.			
1)🖂	Responsive to communication(s) file	d on <u>02 <i>June 200</i>3</u>	•					
2a) <u></u> ☐	This action is <b>FINAL</b> . 2l	b)⊠ This action is	s non-final.					
3)□ Dispositi	Since this application is in condition to closed in accordance with the practic on of Claims	for allowance exce ce under <i>Ex parte</i> (	pt for formal mat Quayle, 1935 C.E	ters, prosecution as to the mo D. 11, 453 O.G. 213.	erits is			
·	Claim(s) 29-74 is/are pending in the a	application						
	4a) Of the above claim(s) is/are	•	onsideration					
_	Claim(s) is/are allowed.	withdrawn from Ct	nisideration.					
<i>'</i>	Claim(s) <u>29-74</u> is/are rejected.							
	Claim(s) is/are objected to.							
	Claim(s) are subject to restriction	on and/or alaction :	roquirom ant					
	on Papers	on and/or election i	requirement.					
9) 🗆 🗆	The specification is objected to by the I	Examiner.						
	The drawing(s) filed on is/are: a		objected to by th	ne Examiner				
·	Applicant may not request that any object							
11)[] 7	The proposed drawing correction filed of							
	If approved, corrected drawings are requ			esperated by the Examinor.				
12)[] 7	he oath or declaration is objected to b							
Priority u	nder 35 U.S.C. §§ 119 and 120			•				
	Acknowledgment is made of a claim fo	or foreian priority ur	nder 35 U.S.C. &	119(a)-(d) or (f)				
_	☐ All b)☐ Some * c)☐ None of:	ar vereign priemy ar		110(a) (d) 01 (i).				
	1.☐ Certified copies of the priority do	ocuments have hee	en received					
				unlication No				
	<ul> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>See the attached detailed Office action for a list of the certified copies not received.</li> </ul>							
	cknowledgment is made of a claim for				iooti\			
	☐ The translation of the foreign langu				ication). ,			
15)∐ Á	cknowledgment is made of a claim for	domestic priority u	nder 35 U.S.C. §	§§ 120 and/or 121.				
\ttachment(								
2) 🔲 Notice	of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO ation Disclosure Statement(s) (PTO-1449) Pape	9-948) er No(s) <u>6</u> .		ummary (PTO-413) Paper No(s) formal Patent Application (PTO-152)				
. Patent and Tra FO-326 (Rev		Office Action Summar	у	Part of Paper No. 9				

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## Election/Restrictions

Applicant's election with traverse of Group III, claims 29-74 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that all the claims are sufficiently related so as to not impose an undue burden on the Examiner to search the related groups. This is not found persuasive because the inventions are distinct and would require different areas of search. For example, a phase separated mixture of a hydrophilic lubricating material and an oleophilic material is completely different than a liquid hydrocarbon oil.

The requirement is still deemed proper and is therefore made FINAL.

## **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29-74 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-68 of U.S. Patent No. 6,576,298 B2 ["Bennett et al"]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method comprising (open-ended) lubricating the interface

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between a conveyor and a shaped article with a liquid hydrocarbon oil or emulsion stable to phase separation which may comprise an additive may be the same.

Claims 29-61 are also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,427,826 B1 ["Li et al"]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of lubricating the interface between a container and a moving conveyor surface may be the same.

Claims 62-74 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 39, 45-47, 51, 56-58, 60-61, 68-70 of prior U.S. Patent No. 6,427,826 B1 (Li et al). This is a double patenting rejection. These claims are identical.

## Conclusion

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Primary Examiner
Art Unit 1764

EMcAvoy August 4, 2003